

REMARKS

Claims 2 and 5-20 remain pending in the instant application after the foregoing amendments. Claims 11 and 17-20 are withdrawn in light of the election of an invention in response to a Restriction Requirement. The claims have been rejected for the reasons noted herein below. Applicants respectfully request reconsideration of the application in light of the amendments and the following remarks.

The Examiner has required a restriction between the product claims and the process claims. Applicants hereby affirm the telephonic election, without traverse, made by Ms. Beeler of the invention of Group I and the species compound 1-7.

The Examiner has objected to Claim 1 because of the spelling of "pharmaceutically". Applicants note that they have cancelled Claim 1 without prejudice to filing a continuing application directed to the subject matter claimed therein. The Examiner's objection is therefore moot.

The Examiner has rejected Claims 1, 10, 12, 13 and 14 under 35 U.S.C. 102(b) as being anticipated by Hcaplus 1999:287417. Applicants note that Claim 1 has been cancelled without prejudice and Claims 10, 12, 13 and 14 have been amended to now depend from Claim 2, thereby rendering the Examiner's rejection of Claim 1 now moot. Applicants note that the compounds currently claimed are all characterized by phenyl moieties at the 2- and 4-positions of a 1,2,5,6-tetrahydropyridine ring. Applicants further note that the instantly claimed compounds lack a substituent at the 6-position of the tetrahydropyridine ring. Applicants note that the compound in the Hcaplus reference is characterized by a 2,6-diphenyl-4-morpholino substitution pattern around the tetrahydropyridine ring. Applicants respectfully contend that one of ordinary skill in the art would have no reason to modify the compound of the prior art (by removing one of the phenyl moieties and converting the morpholine moiety into a phenyl moiety in order to create the instantly claimed compounds. Therefore, Applicants respectfully contend that the compound identified by the Examiner in Hcaplus would also not render the current claims obvious.

The Examiner has rejected Claims 1-5, 10, 12, 13 and 14-16 under 35 U.S.C. 112, first paragraph. The Examiner suggests that the specification does not fully enable compounds of the formula I with R^1 , R^6 , R^8 and R^9 equal to all of the moieties claimed. Applicants note that Claim 1 has been cancelled and Claim 2 has been rewritten in independent form. Applicants

note that Claim 2 incorporates the definition of R¹ that is found in Claim 4 as originally filed. Claim 2 now incorporates the definitions of R², R³ and R⁷ found on page 18, line 27, and page 19, line 3. Amended Claim 2 also incorporates the definitions of R⁴, R⁵ and R⁹ found on page 19, lines 1-2 of the application as originally filed.

Applicants respectfully contend that the current focus of Claim 2 mirrors the specific compounds that have been made and tested to exemplify the claimed invention. Applicants respectfully contend that the specific example compounds whose syntheses and testing is described in the application and the Reaction Schemes set out in the application together would readily allow one of ordinary skill in the art to make, use and test the claimed compounds without any undue additional experimentation. Applicants therefore respectfully contend that the Examiner's rejection under 35 U.S.C. 112, first paragraph, is moot in light of the amendments and that it should be withdrawn.

Applicants respectfully contend that Claims 2 and 5-20, as amended are allowable and a Notice of Allowance is respectfully requested. If a telephonic communication with the Applicants' representative will advance the prosecution of the instant application, please telephone the representative indicated below. Applicants believe no additional fees are due but the Commissioner is authorized to charge any fees required in connection with this amendment to Merck Deposit Account No. 13-2755.

Respectfully submitted,

By 

David A. Muthard
Registration No. 35,297
Attorney for Applicants

Merck & Co., Inc.
PO Box 2000 - RY 60-30
Rahway, New Jersey 07065-0907
Telephone No. (732) 594-3903

Date: September 19, 2008